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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,868	03/06/2002	Richard P. Szajewski	81247ACPK	7890

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Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/30/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,868

Applicant(s)

SZAJEWSKI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5, 7, 8, 9, 16, 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of term "most preferable" render the claim unclear with respect to scope of protection sought for grain thickness presented the claim 5. Claim 8 is unclear with respect to the antecedent basis for "the amount of permanent Dmin adjusting dyes" since the adjusting dyes are not provided in claim 1. Claim 16 is unclear as to when the steps of using the technologies: electrography; inkjet; thermal dye sublimation, or CRT or LED printing to sensitized photographic paper is performed. It is unclear whether the "sensitizing photographic paper" is the photothermographic presented in claim 10 or otherwise.

The scope of protection sought for the "color mask coupler", permanent Dmin adjusting dyes, permanent antihalation density in claims 7, 8, 9 19-20 is unclear since these terms are not defined in the specification disclosure.

3. Claim 9 recites the limitation " the permanent antihalation dye" in line 2. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 19 recites the limitation "'the total amount of masking coupler, the total amount of permanent Dmin adjusting dye, and the permanent antihalation density" in lines 1-4. There is insufficient antecedent basis for this limitation in the claim. The

masking coupler, permanent Dmin adjusting dyes and permanent antihalation density are not presented in claim 10. Therefore, there is no basis for the amount thereof.

5. Claim 20 recites the limitation "'the total amount of masking coupler, the total amount of permanent Dmin adjusting dye, and the permanent antihalation density'" in lines 1-4. There is insufficient antecedent basis for this limitation in the claim. The masking coupler, permanent Dmin adjusting dyes and permanent antihalation density are not presented in claim 10. Therefore, there is no basis for the amount thereof.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ishikawa et al (Ishikawa).

The material of Ishikawa in columns 119-120 contains silver halide within the amount of 1.19 g/m² within the scope of the claimed invention; the binder is gelatin. The material contains blue, green and red sensitive layers. Therefore, the claimed invention lacks novelty.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0800114 (EP'114).

The material of the EP'114 in Table 1, pages 31-35 contains multiple hydrophilic colloid layer comprising blue sensitive layer, green sensitive layer and red sensitive layer wherein the amount of silver halide in the element is 3.957 g/m^2 . The amount of photosensitive silver halide in the range of 0.05 to 20 g/m^2 , more preferably 0.1 to 10 g/m^2 is disclosed on page 16, lines 30-33. Therefore, EP'114 exemplifies the amount of silver halide in the element within the scope of the claimed invention. Therefore, the invention as claimed lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art to use the amount of silver halide suggested therein to provide the invention as claimed.

10. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'114 as applied to claims 1-3 above, and further in view of Bohan et al (Bohan).

Bohan discloses the use of color masking coupler, incorporated permanent Dmin adjusting dye within the amount of up to 0.05 mmol/m^2 and amount up to 0.02 mmol/m^2 . The optical density after processing of less than 0.05 on the average to red, green, and blue light in column 10, lines 45-54. In column 7, lines the use of silver halide having grain thickness of $0.5 \text{ }\mu\text{m}$ or less. In column 11, lines 9-14, it is disclosed that the limiting amount of color masking couplers and incorporated permanent Dmin dye serve to reduce the optical density of the film and to improve scanning and

digitations of the imagewise exposed and process film. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the color masking coupler and the incorporated permanent Dmin dye in combination with silver halide grains having thickness taught in Bohan to reduce the optical density of the film and to improve scanning and digitations of the imagewise exposed and process film, and thereby provide an invention as claimed.

11. Claims 1, 4-15 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohan et al (Bohan).

See Bohan in example 1 in column 18, photographic film sample 1 which contains blue, green and red silver halide emulsion layer having total amount of silver halide of 4.04 g/m² which is within the scope of 1.4 to 4.5 g/m², average grain thickness of 0.06 µm, 0.09 µm and 0.14 µm; in column 38 wherein the amount of color masking dye up to 0.05 mmol/m²; in column 38, claim 10 wherein the incorporated permanent Dmin adjusting dye in an amount up to 0.02 mmol/m². See also the amount of color masking dye and an incorporated permanent Dim adjusting dye in column 5, lines 60-65, and optical density after processing of less than 0.05 on the average to red, green, and blue light in column 10, lines 45-54. The color development is carried out at temperature of from about 40 deg. C to 60 deg. C (column 38, claims 14). The scanning process can be performed after color development, and the desilvering after color development is optional (Abstract). The material of Bohan is carried out at the temperature of 40 °C to 60 °C. This material is therefore considered as a photothermographic material within the meaning of the claimed color photothermographic material. The material contains

the amount of silver halide within the scope of the claimed invention and developed with similar process. Therefore, the claimed invention lacks novelty.

12. Claims 10-16, 18 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0800114 (EP'114).

The material of the claimed process is disclosed in EP'114, Table 1 on pages 31-35 such as discussed in the paragraph 7 above. Moreover, EP'114 in the abstract discloses the step of heating the imagewise exposed material and the process the scanning the image to reproduce the digital image data. See especially page 15, lines 2-35, pages 22-27, abstract and Fig.2. The EP'114 discloses a process of developing similar material presented in the claimed invention comprising thermally developing the imagewise exposed element and scanning the developed element to generate reproducible digital image. Thus, the process as claimed is anticipated by the teaching of EP'114; alternatively, it would have been obvious to the skill of ordinary skill in the art to develop the material of EP'114 by other known wet process such as taught therein.

13. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'114 as applied to claims 10-16, 18 above, and further in view of Bohan et al (Bohan).

Bohan discloses the use of color masking coupler, incorporated permanent Dmin adjusting dye within the amount the amount of up to 0.05 mmol/m^2 and amount up to 0.02 mmol/m^2 . The optical density after processing of less than 0.05 on the average to red, green, and blue light in column 10, lines 45-54. In column 7, lines the use of silver halide having grain thickness of $0.5 \text{ }\mu\text{m}$ or less. In column 11, lines 9-14, it is disclosed

that the limiting amount of color masking couplers and incorporated permanent Dmin dye serve to reduce the optical density of the film and to improve scanning and digitations of the imagewise exposed and process film. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the color masking coupler and the incorporated permanent Dmin dye in combination with silver halide grains having thickness taught in Bohan to reduce the optical density of the film and to improve scanning and digitations of the imagewise exposed and process film, and thereby provide an invention as claimed.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'114 as applied to claims 10-16, 18 above, and further in view of Sato et al (Sato).

Sato discloses a heat-developable material containing a block developer of formula (Z), light-sensitive silver halide and organic silver salt. See especially the composition of the material in the abstract and organic silver salt in column 16, lines 12-18. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the block developer taught in Sato in the material of EP'114 to provide a color image, and thereby provide a process as claimed.

Double Patenting

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claims 10-16 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10-16, 21-23 of copending Application No. 09/855,051. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The process has been allowed in the copending application, and has been directed to the same process.

Conclusion

17. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.


Application/Control Number: 10/091,868

Page 9

Art Unit: 1752

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
December 26, 2002


Thorl Chea
Primary Examiner
Art Unit 1752